

REMARKS

Claims 1-39 are all the claims pending in the application, with claims 1, 31, and 39 being the only independent claims.

As a preliminary matter, Applicant notes that the current Office Action does not comment on Applicant's remarks submitted in the previous response relating the rejection under 35 U.S.C. §101. The current action also does not have such a rejection, and thus, it is believed that Applicant's previous remarks and amendment addressed the points raised in that rejection.

Claims 1-23, 31-34, and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baudel et al. (5,666,499) in view of newly cited Barber et al. (5,586,243). Claims 24-30 and 36-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baudel and Barber, and further in assorted other references identified on pages 14-19 of the current Action. Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

Rejections under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, the Examiner bears the burden of demonstrating that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there is a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

(A) ALL CLAIM ELEMENTS ARE NOT TAUGHT

Tool Palette 406 is not an electronic document

Claim 1 is directed toward a method for facilitating computer editing of an electronic document and recites "positioning a first cursor at a first location within said electronic document . . . [and] . . . positioning a second cursor at a second location within said electronic document . . ."

Page 3 of the present Office Action addressed the claimed first and second cursor elements of claim 1. In particular, using Baudel, the Office Action equates primary cursor 402 with the claimed “first cursor” and secondary cursor 410 with the claimed “second cursor.” For the sake of argument, Applicant assumes that Baudel provides such description. Portions of Baudel which relate to these cursors are as follows:

“Fig. 4(a) illustrates a main application area 400 with only data and a primary cursor 402 (i.e., cursor controlled by primary pointer device 114) being shown on the display of graphics terminal 118.” (Col. 5, lines 42-45).

“A secondary cursor 410 (i.e., cursor controlled by secondary pointer device 116) is displayed on tool palette 406 highlighting a selected tool.” (Col. 5, lines 50-53).

Applicant further assumes *arguendo* that main application area 400 of Baudel discloses an electric document, such that the displaying of primary cursor 402 (first cursor) on main application area 400 discloses “positioning a first cursor at a first location within said electronic document.” Even if this were true, claim 1 is distinguishable since secondary cursor 410 is not described as being displayed on application area 400. To the contrary, Baudel explicitly states that secondary cursor 410 is displayed on tool palette 406. See also Fig. 4(b) of Baudel.

The distinction is that tool palette 406 of Baudel is not an “electronic document.” Tool palette 406 is simply a scheme which permits a user to invoke and select tools of an application. See, for example, col. 4, lines 22-25. It is understood that conventional tool palettes, which Baudel appears to describe, are merely parts of applications which may be used in association with an electronic document. However, such tool palettes are not themselves electronic documents. Thus, even if a cursor is positioned at a location within tool palette 406, such teachings do not include positioning the cursor at a location within an electronic document. The reason is clear; tool palette 406 is not an electronic document.

Claim requires same electronic document

To further support Applicant's position on this point, recall that claim 1 requires that the positioning of the first and second cursors involve the same electronic document to the extent that claim 1 requires "positioning a first cursor . . . within said electronic document . . . [and] . . . positioning a second cursor . . . within said electronic document . . ."

The Baudel system, in contrast, describes displaying primary cursor 402 in application area 400, and displaying secondary cursor 410 on the completely different area of tool palette 406. Tool palette 406 is not the same thing as application area 400. Assuming *arguendo* that tool palette 406 and main application area 400 are both electronic documents, claim 1 is still distinguishable since they are not the same electronic document.

The newly cited Barber reference is similarly deficient. See, for example, Fig. 6 which depicts various pointers 74, 76, 78 which are displayed in different workspaces 88, 90, and 92, respectively. (Barber col. 11, lines 55-63).

Applicant has demonstrated that both Baudel and Barber do not teach or suggest the identified features of claim 1. Therefore, for the reasons presented above, even if one skilled in the art were to combine the teachings of Baudel and Barber in the manner asserted, claim 1 would be patentable since not all of the recited claim elements are taught or reasonably suggested. MPEP § 2143.

(B) NO SUGGESTION TO COMBINE

It is well established that "[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Page 4 of the Action alleges that it would be obvious to one of ordinary skill in the art "to modify the two input device control of Baudel, to use the single input device to control multiple cursors, as did Barber." The Action indicated that the motivation for such a combination was that such an arrangement "provides for the control of multiple cursors without requiring a second control device to control the second cursor, thereby encompassing multiple controls in one device." (Office Action, pg. 4).

Applicant first submits that the changes to the Baudel system proposed by the Action would render Baudel unsatisfactory for its intended purpose. In particular, Baudel clearly states in the very first sentence of the abstract that its purpose is for enhanced user interaction with an application program utilizing "two-handed" techniques. The only embodiment described by Baudel involving two cursors relates to this "two-handed" technique.

This "two-handed" technique is one in which two different devices (i.e., devices 114, 116) are used for positioning two cursors (cursors 402, 410). (Baudel col. 5, lines 41-51). Baudel further emphasizes that the predominant feature of its invention uses the two-handed technique, which requires the use of both devices 114, 116. Indeed, Baudel refers to the so-called "two-handed" technique on at least 16 different occasions. An example of Baudel's insistence of the use of two devices in the "two-handed" technique is reproduced below:

"As will be apparent by the discussion below, a predominant feature of the invention is its conformity with how the user works cooperatively with both hands in the everyday world or "real domain." That is, the user's dominant hand is mainly used to control a primary cursor or tools, such as paint brushes, while the user's non-dominant hand is generally used to control tool palettes." (Baudel col. 4, lines 50-56). (Emphasis added).

Baudel therefore makes clear that its intended purpose is to permit a user to work with both hands. This is accomplished by using two different devices; namely, devices 114, and 116.

The modification proposed by the current Action is to modify the two input device control of Baudel to include the single input device of Barber. However, even if this modification were possible, it would completely destroy the entire purpose of Barber. In particular, such modification would completely obviate the "predominant feature" of Baudel, which is to permit a user to use both hands. Since the proposed modification would utterly eliminate the "predominate feature" of Baudel, it would therefore render the Baudel system unsatisfactory for its intended purpose. In such circumstances, MPEP § 2143.01 compels a finding that there is no suggestion or motivation to make the proposed modification to Baudel.

Applicant recognizes that Fig. 2 of Baudel depicts a "one-handed" operation module. However, this module is implemented only when two cursors are no longer desired. (Baudel col. 5, lines 10-11).

Once again, the modification proposed by the Action is to modify the two input device control of Baudel to include a single input device according to Barber. However, in considering such a modification, one must look to the primary reference being modified to see what that reference describes with regard to such a modification. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (emphasis in original)).

In this case, one must consider what Baudel describes with regard to the use of a single input device. In this regard, Baudel states that “one-handed” operation utilizes a single input device (conventional single pointer), which provides only a signal cursor. In other words, Baudel itself provides teachings relating to a modification from a two input device system to a one input device system. Such teachings unambiguously provides that this one input device system is used when a user no longer desires two cursors. To assert that the single input device of Baudel can be modified to provide two cursors, as alleged in the Action, is to contradict the explicit teachings of Baudel, which is clearly improper according to MPEP § 2141.02.

In summary, Applicant submits that that a prima facie case of obviousness has not been established since (1) the cited references, alone or in combination, do not teach at least on element recited in claim 1; and (2) there is no suggestion to combine Baudel and Barber in the manner alleged. For either or both of these reasons, it is believed that claim 1 is patentable over the cited references. Independent claims 31 and 39 include language similar to that of claim 1, and thus, are believed to be patentable for reasons similar to those discussed with regard to claim 1. The rejected dependent claims are believed to be patentable at least by virtue of their respective dependence on the patentable independent claims.

CONCLUSION

In view of the above, Applicants submits that the currently pending claims are in condition for allowance. Early issuance of a Notice of Allowance is respectfully requested.

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